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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/226, 971 01/08/99 MARRA

M LE9-98-030

TM02/0214

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EXAMINER

GARLAND, S

ART UNIT PAPER NUMBER

2121

DATE MAILED:

02/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/226,971	MARRA ET AL.
Examiner	Art Unit	
Steven R Garland	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_ .
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3, 5, and 8 is/are rejected.
- 7) Claim(s) 4, 6, 7 is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .
- 18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: \_\_\_\_\_ .

## DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsieh 5,212,434.

See figure 1 and note elements 10, 30, 31, 60, 82 and their description. Also note that the frequency output of element 82 is dependent on the control signal output by element 70 and that the pulse output of element is a function of time ( varies with time ).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2121

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2 , 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh 5,212,434 in view of either Long 4,494,509 or O'Sullivan 6,043,695.

Hsieh teaches comparing pulse trains and generating a control signal in response to the comparison. See figure 1 and note elements 10, 30, 31, 60, 82 and their description. Also note that the frequency output of element 82 is dependent on the control signal output by element 70 and that the pulse output of element is a function of time ( varies with time ).

Hsieh however does not state that the leading edges of the pulses are used by the phase comparator to determine the error.

Long in col. 10, lines 61-65; and O'Sullivan in col. 4, lines 59-65; teach comparing the leading edges of pulse trains for ease in determining the phase error.

It would have been obvious to one of ordinary skill in the art to modify Hsieh in view of Long or O'Sullivan and use the leading edges for ease in determining the phase error.

In regards to claims 3 and 5, element 21 of Hsieh generates a pulse train (+ or - ) that represents the error between the pulse trains. Note figures 6A- 7C.

Art Unit: 2121

5. Claims 4, 6, and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 703-305-9759. The examiner can normally be reached on Monday-Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Grant, can be reached on (703) 308-1108. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6606.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3800.

*Steven R. Garland*  
Steven R Garland  
Examiner  
Art Unit 2121

*William Grant*  
WILLIAM GRANT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

*2/12/01*